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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,356	02/12/2002	Brian N. Tufte	1076.1101105	9075
28075	7590	02/07/2005	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/074,356

Applicant(s)

TUFTE, BRIAN N.

Examiner

Ismael Negron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-14, 16-24 and 26-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22, 23, 26-29 and 31-34 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-14, 16-21, 24, 30 and 35-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed on December 7, 2004 has been entered. Claims 1, 6, 9-11, 14, 19, 21, 23, 25, 26-31 and 35-50 have been amended. No claim has been cancelled or added. Claims 1-3, 6-14, 16-24 and 26-50 are still pending in this application, with claims 1, 10, 11, 19, 21-24 and 26-31 being independent.

### ***Information Disclosure Statement***

2. Applicant request for consideration of an Information Disclosure Statement supposedly filed electronically on August 31, 2004 is noted, however, no such document is present in the instant application file.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6-14, 16-21, 24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).

BURKITT, III et al. discloses an elongated illumination device having:

- **an elongated member (as recited in claims 1, 10, 11, 19, 21, 24 and 30), Figure 2, reference number 14;**
- **an elongated light source (as recited in claims 1, 10, 11, 19, 21, 24 and 30), Figure 2, reference number 12;**
- **the elongated member having a cavity (as recited in claims 1, 10, 11, 19, 21, 24 and 30), Figure 2, reference number 28;**
- **the cavity being for receiving the elongated light source (as recited in claims 1, 10, 11, 19, 21, 24 and 30), column 3, lines 44-46;**
- **at least part of the cavity being defined by an at least semi-transparent material extending from the cavity to an outer surface of the elongated member (as recited in claims 1, 16, 20, 21 and 24), column 3, lines 52-54;**
- **an elongated carrier (as recited in claims 1, 10, 11, 19, 21 and 30), Figure 2, reference number 16;**
- **the elongated carrier having a slot (as recited in claims 1, 10, 11, 19, 21 and 30), as seen in Figure 2;**
- **the slot being for receiving the elongated member (as recited in claims 1, 10, 11, 19, 21 and 30), as seen in Figure 2;**
- **the slot and the elongated member being adapted so that the elongated member must be at least partially elastically**

**deformed or bent to insert the elongated member into the slot (as recited in claims 1, 10, 11, 12, 21 and 30), column 3, lines 60-66;**

- **at least part of the elongated member being at least partially elastically deformed or bent to insert the elongated light source through the slit into the cavity (as recited by claim 2), column 3, lines 60-66; and**
- **the elongated light source being a linear emitting fiber (as recited in claims 8 and 18), column 3, lines 44-46.**

BURKITT, III et al. discloses all the limitations of the claims, except:

- **at least part of the cavity being defined by a non-transparent material extending from the cavity to an outer surface of the elongated member (as recited in Claim 24);**
- **the elongated member having an elongated slit or opening (as recited in claims 1, 10, 11, 19, 21, 24 and 30);**
- **the elongated slit or opening extending from the cavity to an outer surface of the elongated member (as recited in claims 1, 10, 11, 19, 21, 24 and 30);**
- **the elongated carrier providing a closing force to the elongated slit or opening of the elongated member (as recited in claims 6, 10, 11 and 30);**

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- means for latching the slit into a closed or substantially closed position (as recited in claims 3 or 13)
- the elongated slit or opening facing the elongated carrier when the elongated member is received by the elongated carrier (as recited in Claim 19);
- the elongated light source being an electro luminescent wire (as recited in claims 7, 17 and 19);
- the slit being normally open so that the light source might be inserted (as recited in claims 9 and 14);
- the elongated member being at least partially elastically deformed or bent to close the slit (as recited in claims 9 and 14); and
- the two slit defining surfaces touching one another at least over a majority of the length of the elongated carrier (as recited in Claim 24).

BELL (U.S. Pat. 5,410,458) discloses illumination device having:

- **a light source (as recited in claims 1, 10, 11, 19, 21, 24 and 30),**  
Figure 4, reference number 116;
- **an elongated member (as recited in claims 1, 10, 11, 19, 21, 24 and 30),** Figure 4, reference number 104
- **the elongated member having a cavity (as recited in claims 1, 10, 11, 19, 21, 24 and 30),** as seen in Figure 4;

- **the cavity being for receiving the light source (as recited in claims 1, 10, 11, 19, 21, 24 and 30), column 3, lines 30-33;**
- **at least part of the cavity being defined by an at least semi-transparent material extending from the cavity to an outer surface of the elongated member (as recited in claims 1, 16, 20, 21 and 24), columns 2 and 3, lines 66-68 and 1-2, respectively;**
- **at least part of the cavity being defined by a non-transparent material extending from the cavity to an outer surface of the elongated member (as recited in Claim 24), column 3, lines 64-68;**
- **the elongated member having an elongated slit or opening (as recited in claims 1, 10, 11, 19, 21, 24 and 30), Figure 4, reference number 110;**
- **the elongated slit or opening extending from the cavity to an outer surface of the elongated member (as recited in claims 1, 10, 11, 19, 21, 24 and 30), as seen in Figure 4;**
- **the elongated light source being an electro luminescent wire (as recited in claims 7, 17 and 19), as suggested in column 3, lines 56-60;**
- **the slit being normally open so that the light source might be inserted (as recited in claims 9 and 14), as seen in Figure 4; and**

- **the elongated member being at least partially elastically deformed or bent to close the slit (as recited in claims 9 and 14), as suggested by Figure 4.**

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the slit of BELL in the elongated member of BURKITT, III et al. to be able to easily remove the light source in the event that it needs service or replacement, as per the teachings of BELL (see column 3, lines 51-55). It would have further being obvious to place such slit on the side facing the elongated carrier (as recited in claims 19 and 32) for presenting a continuous and uniform output surface and for preventing the light source from being accidentally removed from the elongated member. Such arrangement would inherently force the elongated carrier to provide a latching function with closing force to the slit (as recited in claims 3, 6, 10, 11, 13 and 30).

The examiner takes Official Notice that the use of ELEs is old and well known in the illumination art. Even if BELL lacked suggestion to use an electro luminescent (ELE) light string (which it does not), it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a ELEs for the incandescent light string in the system of BELL. One would have been motivated since ELEs are recognized in the illumination art to have many desirable advantages, including reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources.



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Regarding the two slit defining surfaces touching one another at least over a majority of the length of the elongated carrier (as recited in Claim 24), the slit structure of BELL was considered equivalent to the claimed slit structure since the applicant has not disclosed that the slit defining surfaces touching one another at least over a majority of the length of the elongated carrier solves any problem or is for a particular reason. It appears that the claimed invention would perform equally well with the slit as disclosed by BELL.

4. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).

The teachings of BURKITT, III et al. and BELL disclose individually, or suggest in combination, all the limitations of the claims (as detailed in Section 2 of the instant Office Action), except the elongated carrier being secured to a stair step.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to secured the device of BURKITT, III et al. and BELL, since such limitations are directed to a recitation of the intended use of the claimed invention, without resulting in any structural difference between the claimed invention and the structure disclosed by the combined teachings of BURKITT, III et al. and BELL, and therefore fails to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, figures 1 and 2 of BURKITT, III et al., show the elongated carrier 16

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fastened by screws 20 and adhesive 26 to surface 18. Selecting the surface 18 to be the surface of a stair step does not distinguish the claimed invention from the prior art.

5. Claims 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).

The teachings of BURKITT, III et al. and BELL disclose individually, or suggest in combination, all the limitations of the claims (as detailed in Section 2 of the instant Office Action), except the elongated carrier being providing a bumper function (as recited in claims 39, 43 and 47), such bumper function being for a boat (as recited in claims 40, 44 and 48), a wall (as recited in claims 41, 45 and 49) or shelving (as recited in claims 42, 46 and 50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the apparatus formed by the combined teachings of BURKITT, III et al. and BELL provides such bumper function (as recited in claims 39, 43 and 47) as the elongated member 14 is disclosed as being made of a flexible plastic (column 3, lines 52-54), and 14 having a bumper-like geometry as evidenced by Figure 2.

In addition, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the device of BURKITT, III et al. and BELL to provide a bumper function for a boat (as recited in claims 40, 44 and 48), a wall (as recited in claims 41, 45 and 49) or shelving (as recited in claims 42, 46 and 50), since such limitations are directed to a recitation of the intended use of the claimed invention, without resulting in any structural difference between the claimed invention and the

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structure disclosed by the combined teachings of BURKITT, III et al. and BELL , and therefore fails to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, a recitation of the claimed invention being provided in a boat, a wall or shelving does not distinguish the claimed invention from the prior art.

***Allowable Subject Matter***

6. Claims 22, 23, 26-29 and 31-34 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches an illumination device having an elongated light source received in a cavity of an elongated member, such member being received in a slot of an elongated carrier. The elongated light source is inserted in the cavity through a slit formed in the elongated member. The slot and the member are adapted so that when the elongated member is in the slot, the carrier provides a closing force to keep the slit in the elongated member closed, or substantially closed. The elongated member having an at least partially transparent material and a non-transparent material. The carrier is at least partially deformed to receive the elongated member.

No prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention, specifically the elongated member having an at

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least partially transparent material and a non-transparent material, or the carrier being deformed to receive the elongated member.

### ***Response to Arguments***

8. Applicant's arguments filed December 7, 2004 have been fully considered but they are not persuasive.

9. Regarding the Examiner's rejection of claims 1, 19 and 21 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458), the applicant argues that there is no motivation to include the slit of BELL in the back side of the elongated member of BURKITT, III et al.. BELL, the applicant argues, clearly suggests placing the slit somewhere that is accessible from the outside of the elongated carrier (e.g. front surface of the elongated member).

With respect to claims 2, 3, 6-9, 20, 35, 37-42 and 47-50 the applicant presents no arguments, except stating that such claims are dependent upon claims 1, 19 or 21 and would be allowable when/if the independent claim are allowed.

10. In response to applicant's arguments that there is no motivation to include a slit in the back side of the elongated member of BURKITT, III et al., the applicant is respectfully directed to Figure 2 of BURKITT, III et al., such figure disclosing an elongated illumination device 10 having an elongated light source 12 located inside an elongated member 14, such member 14 being received in an elongated carrier 16. The

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elongated carrier 16 has a backside 42 and a pair of sidewalls 40 defining the slot where the elongated member 14 is received. In addition, BURKITT, III et al. specifically states a desire to present a continuous and uniform output surface, and to prevent children from easily removing the light source from the device (see column 2, lines 7-49).

BELL on the other hand discloses a light source 116 positioned inside an elongated member 104 having a slit 110. BELL discloses the slit 110 as facilitating the insertion and removal of the light source 116 from the member 104, further stating that a member such as elongated member 104 without the advantages of slit 110, while possible, is not preferred.

As the applicant would surely agree, the disclosure of BELL provides ample motivation to compel one of ordinary skill in the art to include a slit in the elongated member of BURKITT, III et al..

Regarding the slit being located specifically in the back side of the member 14 of BURKITT, III et al. reminded that the claims were rejected over BURKITT, III et al. in view of BELL (e.g. BELL is improving BURKITT, III et al.), not vice versa. It appears that the applicant is attempting to import the whole of the structure and intended use of BELL into the patented apparatus of BURKITT, III et al., however, it is only the teaching of the slit that is taken from BELL into BURKITT, III et al..

While it might be true that BELL teaches the slit 110 as providing simple and easy access to the light source 116, it is also a fact, as admitted by the applicant, that the slit 110 is located in a back side of the member 104, such back side facing the

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elongated carrier 102. The member 104, having the necessary slit 110 located in its backside presents a continuous and uniform surface for outputting the light emitted by the light source 116. Exporting the slit 110 of BELL, and its location with respect to the elongated member, to the patented structure of BURKITT, III et al. would have flown naturally to one of ordinary skill in the art at the time the invention was made, as disclosed by BELL. In addition, while it might be argued that the proposed combination of references fails to improve on the structure of BELL, it is undeniable that the same can not be said of BURKITT, III et al., as locating a slit in the back side of the member 14 of BURKITT, III et al. would definitively provide such member with a simpler and easier way of inserting and removing the light source 12.

11. Regarding the Examiner's rejection of claims 10, 11 and 30 under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the elongated carrier providing a closing force to the elongated slit of the elongated member. The applicant further argues that the Examiner erred in considering such limitation an inherent feature of the structure achieved by the proposed combination, as, while possible, it is not necessarily provided.

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With respect to claims 12-18, 36 and 43-46 the applicant presents no arguments, except stating that such claims are dependent upon claims 10, 11 or 30 and would be allowable when/if the independent claims are allowed.

12. In response to applicant's surprising arguments that the proposed combination of references fail to disclose the elongated carrier providing a closing force to the elongated slit of the elongated member, the applicant is respectfully directed to Figure 2 of BURKITT, III et al..

BURKITT, III et al. discloses an elongated illumination device 10 having an elongated light source 12 located inside an elongated member 14, such member 14 being received in an elongated carrier 16. The elongated carrier 16 has a backside 42 and a pair of sidewalls 40 defining the slot where the elongated member 14 is received.

It appears that the applicant is interpreting the member 14 as being loosely received inside the carrier 16, however, such interpretation goes against the disclosure of BURKITT, III et al..

BURKITT, III et al. states:

- *"This arrangement also provides for increased durability and less of a likelihood that children will remove the tube from the track and damage the lighting system"*, column 2, lines 43-46;
- *"When the edges of the tube are released, they assume their original shape and occupy the space between the flanges on the*

*track. This advantageously results in the tube being secured to the track", column 3, lines 64-67.*

Clearly the elongated member 14 fits snugly inside the elongated carrier 16 (as evidenced not only by the cited passages, but also by Figure 2) with the sidewalls 40 preventing a slit located in a backside of the member 14 from opening. However, even if, in arguendo, the elongated carrier were considered to loosely support member 14, it would still inherently meet the limitations as recited by the claims. The slit would have been provided in the backside of the member 14 for enabling insertion and removal of the light source 12. A condition of the slit preventing such insertion/removal of the light source 12 would clearly represent a closed slit, with an opposite condition (e.g. allowing insertion/removal) represent an open slit. The carrier 16 being made of a rigid material (column 4, lines 11-13) would prevent the slit from being opened by presenting a force urging the slit to remain in the closed position.

13. Regarding the Examiner's rejection of Claim 24 under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the two slit defining surfaces touching one another at least over a majority of the length of the elongated carrier.

14. In response to applicant's arguments regarding the two slit defining surfaces touching one another at least over a majority of the length of the elongated carrier, the



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applicant is advised that the slit structure of BELL was considered equivalent to the claimed slit structure. It appears that the claimed invention would perform equally well with the slit as disclosed by BELL, since the applicant has not disclosed that having slit defining surfaces touching one another at least over a majority of the length of the elongated carrier solves any problem or is for a particular reason.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-

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2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



JOHN ANTHONY WARD  
PRIMARY EXAMINER



Inr

February 2, 2005